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**REMARKS**

This amendment is responsive to the Office Action of January 2, 2004. Claims 15, 17 18, and 24 have been amended for clarification, and claims 25-37 have been added.

On page 2 of the Office Action, the Examiner objects to claims 15, 17, 18 and 24 as being indefinite under 35 USC 112, second paragraph, and makes several suggestions to overcome the indefiniteness. These claims have been amended to overcome the remaining objections and to correct the indefiniteness identified in the Office Action. Applicant respectfully traverses the Examiner's suggestion to replace the recitation "at least one of comprised of and including a portion of", which allegedly is "stilted language." To the contrary, the designations "at least one of", "comprised of" and "including a portion of" are definite and precise, and would be understood by those skilled in the art. It is respectfully submitted that the foregoing language is neither vague nor indefinite, and satisfies the statutory requirements of 35 USC 112, second paragraph. See MPEP § 2173.02.

**Rejection(s) Under 35 U.S.C. § 102 and/or 103**

Beginning on page 2 of the Office Action, the Examiner rejects claim 18 under 35 U.S.C. § 102(e) as being anticipated by *Cyr et al.* (U.S. Patent No. 6,099,930) ("Cyr"). Further, claims 15 and 17 stand rejected under 35 USC 103(a) as being unpatentable over Cyr in view of *Aratani et al.* (U.S. Patent No. 6,063,468) ("Aratani"). Further, claim 24 stands rejected under 35 USC 103(a) as being unpatentable over Cyr in view of *Kane et al.* (U.S. Patent No. 64,571,492) ("Kane"). The rejections, insofar as they may be applied to the claims as amended, are respectfully traversed for reasons including the following.

**Cyr et al. is not available as prior art**

The Section 102(e) date of Cyr is July 20, 1998. The effective filing date of the present application is June 29, 1998. Therefore, Cyr is not prior art under Section 102(e) or Section 103(a) with respect to the present application. The Examiner is respectfully requested to withdraw the rejections based thereon.

Further arguments are presented below concerning Cyr. However, these further arguments are presented in the alternative and do not constitute an admission that Cyr is proper prior art.

### **The Claimed Invention**

As described in the application, the invention is directed to solving the problem of tracking pirated data and/or sources. (Specification p. 2.) At least one aspect of the invention is addressed to, for example, the problem of, *inter alia*, providing a marking mechanism that is not susceptible to damage, alteration, detection, and/or removal. (Specification p. 17.)

The invention, as claimed, is directed to a method for marking a protective layer of a product. Specifically, independent claim 15 recites in combination, for example:

- (a) introducing at least one predetermined tracing substance as a predetermined marking in a polycarbonate material of the polymer of the protective layer of the product in quantities that will not adversely effect at least one of performance, structure of, and the data stored on, the product, the tracing substance being indicative of product information; and
- (b) manufacturing the product with the at least one predetermined tracing substance introduced therein in said introducing step (a).

### **U.S. Patent 6,099,930 (Cyr et al.)**

Independent claim 18 stands rejected under 35 U.S.C. § 102 as anticipated by Cyr, and claims 15, 17 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cyr in combination with other reference(s). The rejection, insofar as it might be applied to the claims as

amended, is respectfully traversed for the following reasons, which are provided by way of example.

Without conceding that Cyr discloses any features of the present invention, and without conceding that Cyr may be properly applied as a reference, Cyr is directed to “a digital recording medium ... having a substrate, a reflective layer and a protective layer includes a near infrared fluorophore in one of the layers.” (Abstract). “[T]he authenticity of the CD can be verified by detection of the near infrared fluorophore using a suitably designed detector.” (Col. 9, lines 53-55).

The Office Action asserts that Cyr teaches or suggests the invention as claimed. To the contrary, Cyr, during operation, does not anticipate the claims as amended, when the combination of features recited therein are considered as a whole. Notable sections of Cyr, according to the Office Action, discuss that “the near infrared fluorophore composition can be incorporated into the substrate polymer or the material used to form the protective layer. Alternatively, one or more near infrared fluorophore composition(s) can be incorporated into or coated onto one or more of the CD surfaces, such as the substrate, the reflective layer, the protective layer, and/or the graphics layer.” (Col. 4 lines 59-64.) “[T]he authenticity of the CD can be verified by detection of the near infrared fluorophore using a suitably designed detector.” (Col. 9 lines 53-55.)

Paragraph 3 of the Office Action admits that Cyr lacks a showing that the protective layer of the product is made from polycarbonate. Paragraph 4 of the Office Action admits that Cyr lacks aspects of a tracing substance, e.g., including a predetermined concentration of an isotope, being indicative of a manufacturer or manufacturing date.

In summary, Cyr teaches applying a method of marking a CD with a fluorophore and detecting the fluorophore. Cyr consequently does not teach or suggest, *inter alia*, a tracing substance “as a predetermined marking”, or “the tracing substance being indicative of product information,” as claimed.

**U.S. Patent 6,063,468 (Aratani *et al.*)**

Independent claims 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyr in view of Aratani. The Office Action admits that Cyr lacks a showing that the protective layer of the product is made from polycarbonate. Aratani allegedly remedies the deficiencies of Cyr. The rejections, insofar as they may be applied to the claims as amended, are respectfully traversed for reasons including the following.

Aratani relates to optical recording medium. Aratani does not discuss a tracing substance as a predetermined marking, nor does Aratani teach or suggest that the tracing substance be indicative of product information. Indeed, Aratani is directed to the problem of reducing or eliminating scratches from the surface of the optical recording medium (Abstract). Hence, Aratani fails to remedy the deficiencies of Cyr.

It is respectfully submitted that claims 15 and 17, as amended, are patentable over Cyr and Aratani, for reasons including those discussed above.

**U.S. Patent 4,571,492 (Kane *et al.*)**

Independent claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyr in view of Kane. The Office Action cites Kane to attempt to remedy the deficiencies of Cyr. The rejection, insofar as it may be applied to the claims as amended, is respectfully traversed for reasons including the following.

Kane discloses a method for identifying, detecting, authenticating and dating an article, comprising radioactive isotopes on or within the article. (Abstract.) Objects of the invention include, among others, detecting unauthorized movement of an article and identifying the article as being authentic (Col. 2 lines 8-18). According to Kane, “[a] common goal for all applications of the present invention is to keep radiation exposures to both the manufacturing employees and general public to a minimum value ...” (Col. 3, lines 35-40). Kane lists suitable exemplary electronic components, including the optoelectronics subcomponents, namely, “displays, lamps, couplers, and other optoelectronics” (Col. 5, lines 1-25), cited by the Examiner. The Examiner states that Kane discloses “labeling.” To the contrary, Kane discusses “dispersing” or “disposing” the radioisotopes on the article. (Col. 4 lines 35-45).

**Claims in Contrast to *Cyr et al.*, *Aratani et al.* and *Kane et al.***

First, Applicant asserts that Cyr et al. is not prior art. Thus, for this reason alone the rejection is traversed. In addition, Cyr is directed to marking a CD with a fluorophore. Aratani is directed to eliminating scratches from an optical recording medium. Nothing in Cyr would suggest that a predetermined tracing substance be introduced into the polycarbonate material. Additionally, nothing in Aratani suggests adding a tracing substance to eliminate scratches. Consequently, Cyr and/or Aratani operate in a fundamentally different way than the claimed invention. Specifically, neither Cyr nor Aratani teach or even suggest, let alone disclose, anything concerning introducing a predetermined tracing substance as a predetermined marking in the polycarbonate material of the polymer of the protective layer of the product, where the tracing substance is indicative of product information as further claimed.

Moreover, the proposed combination fails to make obvious the invention as claimed.

Examples are provided in the following section as to some of the deficiencies that remain in the proposed combination, if made.

The Office Action asserts, for example, that Cyr teaches or suggests a “tracing substance.” Cyr fails to teach or suggest, for example, that the tracing substance is indicative of, for example, product information (e.g., claims 15, 17, 18 as amended). To the contrary, Cyr’s fluorescing compound conveys no product information.

Aratani fails to remedy the deficiencies of Cyr. Nothing in Aratani teaches or suggests introducing a tracing substance as claimed into the polycarbonate material of the polymer of the protective layer of the product, as claimed (e.g., Claim 15).

Moreover, Kane fails to teach or suggest a tracing substance that is indicative of product information including at least two of lot number, batch number, shipper, recipient, shipping date, manufacturer identity, manufacturing date and designated product purpose, as claimed. (e.g., Claim 24). Furthermore, Cyr fails to teach or suggest a data message, as claimed (claim 24). Clearly, Kane fails to remedy the deficiencies of Cyr.

For at least these reasons, the combination of features recited in independent claims 15, 17, 18 and 24, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Cyr clearly fails to show other claimed features as well.

With respect to the new dependent claims, Applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 15, 17, 18, and 24, but also because of additional features they recite in combination.

None of these features mentioned above by way of example is taught or suggested by Cyr; neither Cyr, Aratani nor Kane, alone or in combination, remedy these deficiencies. In view

of the above, Applicant submits that the combination of features recited in each of claims 15, 17, 18, and 24, as amended, is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole.

New claims have been added to further define the invention, and are believed to be patentable for reasons including these set out above.

### **Double Patenting Rejections**

Claims 15 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent 6,477,134. Applicant respectfully traverses this rejection. Specifically, the present application is a divisional application of U.S. Patent 6,477,134 wherein a Restriction Requirement was made, thereby requiring the Applicant to have cancelled claims 15 and 24 from that application. Accordingly, under 35 U.S.C. §121, U.S. Patent 6,477,134 CANNOT be used as a prior art reference against this divisional application that claims priority to U.S. Patent 6,477,134 under 35 U.S.C. §120. The Examiner is respectfully requested to withdraw the obviousness-type double patenting rejection.

### **Summary**

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as

Application No. 10/044,960  
Amdt. dated May 3, 2004  
Reply to Office Action of January 2, 2004

a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. Applicant's assumption arguendo of a position does not constitute a concession of the Examiner's contention. Moreover, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this amendment, such extension is hereby requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed, including any fees required for an extension of time, please charge those fees to our Deposit Account No. 08-0219.

Respectfully submitted,

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